



03-23-06

1614 #
SFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number: 10/084,391
Application Filed: 02/26/2002
Priority Date: 03-03-2000
Applicant: Gregory Gene Steiner
Examiner: Rebecca Cook
Art Unit: 1614
Customer number: 000049284
Application Title: Alpha-pyrone compositions and method for the chemoprevention of cancer.

Mail Stop Amendment
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Mailed 03-21-06
At Ewa Beach, Hawaii

AMENDMENT AND RESPONSE

AMENDMENT C

Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

Sir:

Responsive to the dated October 24, 2005 letter wherein the Examining Attorney rejected claims 1-5 under section 35 U.S.C. 112 the Examining Attorney suggested a modification of the claims that would overcome this rejection which is greatly appreciated by the inventor.

In regard to claims 1-5 rejected under 35 U.S.C. 112 second paragraph, as requested by Examiner Goldberg, the only compounds to be listed in the specifications are Methysticin, Dihydromethysticin and 5,6-Dehydromethysticin as noted in the previous office action dated 03-04-2003. Claims 2-5 have been amended as suggested by the examining officer replacing “comprising” with “in which the composition is”.

The Examining Attorney rejected claim 1 under 35 U.S.C. 102(b), now corrected to 35 U.S.C. 102(a) as being anticipated by CAPLUS DN 131:298760 (Fujiki). The claims of the applicant are established to be novel and unobvious by the attached Declaration of Gregory Gene Steiner, under 37 C.F.R. 1.131, and copies of notes attached thereto, demonstrating that inventor Steiner conceived of and began reducing to practice the invention of kava as being a chemopreventive agent for cancer. During the period November 1997 to December 1998, prior to the publication of Fujiki (Nov. 1999) and further that the inventor Steiner actively and diligently thereafter further reduced this aspect of his invention to practice through February 29, 2000 the date of mailing of Applicant's provisional application upon which the subject is based.

Claims 1-5 were rejected as being unpatentable over CAPLUS DN 131:298760 (Fujiki) under section 35 U.S.C. 103(a). As in the above rejection under 35 U.S.C. 102(a) the declaration of Gregory Gene Steiner outlines that this citation is not prior art and Steiner had reduced his invention to practice long before the publication of Fujiki. It is also noted that Fujiki was discussing the anticancer properties of green tea. In his publication he is discussing beverages consumed by cultures with low cancer incidence rates. He mentions that Fiji has a low cancer incidence rate and they drink kava. Fujiki asserts that there are other cultures with low cancer incidence rates that drink other beverages. Fujiki never states that kava is responsible for the low cancer incidence rates in Fiji and also clearly states that he has not studied kava in regard to its cancer chemopreventive properties and has not reduced it to practice.

Claims 1-5 are rejected under U.S.C. 103(a) as unpatentable over CA 124:220762, the applicant notes that the pyrone compound is not an isomer of the kavapyrones.

The doctrine of double patenting is designed to prevent the improper time wise extension of the right to exclude and harassment from multiple assignees. In this case where the second patent application was required by examiner Goldberg in order to continue prosecution of the application and that there is only one assignee it appears that the doctrine of double patenting does not apply.